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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,502	06/19/2001	Jeffrey A. Bedell	53470.003037	8691

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EXAMINER

HUYNH, CONG LAC T

ART UNIT PAPER NUMBER

2178

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/883,502	Applicant(s) BEDELL ET AL.	
	Examiner Cong-Lac Huynh	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>092402 and 092602</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: the application filed on 6/19/01, and the IDSs filed on 9/24/02 and 9/26/02.
2. Claims 1-28 are pending in the case. Claims 1, 6, 14, 21 are independent claims.

Information Disclosure Statement

3. The information disclosure statement filed 9/23/02 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because some documents are not included in the CD as cited and some have no date. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Double Patenting

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

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A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Claims 1 and 3 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 5 of copending Application No. 09/883,303. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 6 and 8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6 and 10 of copending Application No. 09/883,303. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

'303 discloses:

- specifying one or more of the template or filter properties with a prompt object wherein the prompt object comprises a question to be asked of a user and at least one validation property
- the prompt object further comprises a default answer to the question

'303 does not disclose:

- selecting a template with one or more template properties
- selecting a filter with one or more filter properties

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have included in '303 said selecting steps since the specifying step in '303 implies that when specifying the template or the filter as claimed, the template or the filter must be selected to be specified.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The prompt object as claimed is not a tangible object since it is not embodied in a computer readable medium.

It is suggested that Applicants add the language "on computer medium" to the preamble after "a prompt object" (line 1) to overcome the 101 issue.

10. Claim 6 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The "method of creating a report to be executed on a reporting system" as claimed can be performed on paper, and thus is not in the technological art.

It is suggested that Applicants add the language "computer-implemented" to the preamble before "method of creating ..." (line 1) to overcome the 101 issue.

11. Claim 21 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The system in claim 21 includes the report selection means disclosed in the specification as a report instance (page 17). Such instance is well known as an object defined in programming and is merely a type of software per se. Thus, to be statutory, the report selection means has to be embodied in a computer readable medium, which is a piece of hardware in the system.

Claim Objections

12. Claims 11, 19, 26 are objected to because of the following informalities: regarding claim 11, the phrase "a each properties" after "provided to" (line 3) is a typographical error. Claims 19 and 26 have the same error. Appropriate correction is required.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson et al. (US Pat No. 6,668,253 B1, 12/23/03, filed 8/30/00).

Regarding independent claim 6, Thompson discloses:

- selecting a template with one or more template properties (**col 11, lines 1-15**: determining the report template and placing elements on the template with cross-table for easy data analysis and detail listing for informational display implies that the report template is selected with the format properties)
- selecting a filter with one or more filter properties (**col 11, lines 1-15**: user selects from a list of pre-defined query filters to limit the data shown in the report where it is clear that the filter has properties of the data types acceptable by the filter)

- specifying one or more of the template or filter properties with a prompt object
(**col 10, lines 1-16**: providing the report parameters to the filter for the *autoprompt* shows specifying the filter properties)
- wherein the prompt object comprises:
 - o a question to be asked of a user (**col 11, lines 1-15**: “.. the user can decide from two popular report formats ... Once the report template has been determined and the elements placed on the template, the *user can select from a list of pre-defined query “filters”.. to limit the data shown on the report*”; the query filters are considered as the question in the prompt object asking for a user to identify data from the data warehouse to be included in the selected report template; **col 10, lines 1-16**: the filter selection takes places in a pop-up dialog window where the pop-up dialog is considered as an prompt object comprising a question asking a user to identify an object for processing the report since the pop-up dialog, considered as a prompt, provides a plurality of data categories for a user to select to include in the report, where these actions are considered equivalent to processing the report)

Thompson does not explicitly disclose that the prompt object comprises at least one validation property.

Instead, Thompson discloses the ability to create user definable parameters for querying the data warehouse and filtering information, and the filters provides the report with parameters to narrow the selection of data displayed (col 10, lines 1-16).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Thompson to include the at least one validation property comprised in the prompt object for the following reason. Querying the data warehouse and filtering data retrieved for the report suggests *searching in a data warehouse for an object addressed in a query* to populate in the report since it was well known in the art that searching is a subsequent step when a query is made. Therefore, the user defined parameter is considered as the validation property comprised in the prompt for conducting the query search and *rendering a suitable answer* to said query.

Regarding claim 7, which is dependent on claim 6, Thompson discloses that the prompt object further comprises a prompt type and wherein at least one validation property comprises verification that the answer provided to the question is of the specified prompt type (**col 10, lines 1-16**: the filter selection takes place in a pop-up dialog window where the pop-up dialog is considered as a prompt type providing a plurality of data categories as questions for a user to select one as an data answer to include in a report; **figure 5** shows an autoprompt that allows a user to select a specified data to add, remove, or edit for a report).

Regarding claim 8, which is dependent on claim 6, Thompson does not explicitly disclose that the prompt object further comprises a default answer to the question. However, Thompson does teach the pop-up dialog window for selecting data (col 10, lines 1-16).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Thompson to include the default answer to the question into the prompt object for the following reason. The fact that Thompson discloses the pop-up dialog window for selecting data suggests including the default answer to the prompt object since, as mentioned in claim 6, the pop-up dialog window is considered equivalent to a prompt object, and it was well known that a pop-up dialog has a default answer as a ready choice for a user if he/she does not want to select any other data in the pop-up dialog.

Regarding claim 9, which is dependent on claim 6, Thompson discloses that the prompt object further comprises a meaning that, upon request by a responder to the prompt, provides an explanation of the question (**figure 5**: the autoprompt includes the explanation that the top 10 carlines sold by a dealer 2).

Regarding claim 10, which is dependent on claim 6, Thompson discloses that the prompt object further comprises a reuse value that indicates whether an answer provided from a previous instance of that prompt object, a default value or a new value is to be used for an answer to the question in the prompt object (**figure 5**: the fact that the autoprompt includes the option REMOVE and EDIT inherently shows that the data to be removed or edited is already *selected and used* previously and now said data, which is a reuse value, has to be removed or edited).

Regarding claim 11, which is dependent on claim 6, Thompson discloses specifying a single prompt object for a plurality of properties in the report and wherein upon report execution, the question receives only one answer that is provided to a each properties for which the prompt object was specified (**figures 5 and 7**: the prompt object in figure 5 is specified with the dealership property in the report in figure 7, and wherein upon report execution, the question receives only one answer which is the dealership make provided as the dealership property and specified in the prompt object).

Regarding claim 12, which is dependent on claim 6, Thompson discloses specifying at most one prompt object for a template or filter property (figure 5: the autoprompt object is specified for a filter property).

Regarding claim 13, which is dependent on claim 6, Thompson discloses that the template comprises a set of templates properties and the filter comprises a set of filter properties and wherein every template and filter property may be specified as a prompt object (as mentioned in claim 1, the template has template properties and the filter has filter properties; **figure 5**: the fact that the autoprompt includes the filter that filters 10 carlines by dealer 2 shows that the filter property is specified as a prompt object).

Claims 1-5 are for a prompt object as mentioned in claims 6-10, and are rejected under the same rationale.

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Claims 14-20 are for a processor-readable medium of method claims 6-10, and are rejected under the same rationale.

Claims 21-28 are for a system of method claims 6-13, and are rejected under the same rationale.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Britton (US Pat No. 6,591,289 B1, 7/8/03, filed 7/27/99).

Brandt et al. (US Pat No. 6,377,993 B1, 4/23/02, filed 9/24/98, priority 9/26/97).

Selvarajan et al. (US Pat No. 6,279,033 B1, 8/21/01, filed 5/28/99).

Clancey et al. (US Pat No. 6,292,811 B1, 9/18/01, filed 7/13/98).

Zirngibl et al. (US Pat No. 6,765,997 B1, 7/20/04, filed 2/2/00, priority 9/13/99).

Dardinski et al. (US Pat No. 6,754,885 B1, 6/22/04, filed 11/13/99, priority 5/17/99).

Yost et al. (US Pat No. 6,260,050 B1, 7/10/01, filed 6/30/99, priority 3/23/99).

Morrison et al. (US Pat No. 5,945,990, 8/31/99, filed 11/19/96).

Steinnacher, Monarch / ES Web-enables reports, InfoWorld, Mar 6, 2000, vol. 22, page 57.

Jancsek, Using Technology to modernize loan review at BankAmerica Corporation, Commercial Lending Review, Spring 1997, vol. 12, page 13, 5pgs.

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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-4125.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cong-Lac Huynh
Examiner
Art Unit 2178
10/08/04